

Appln. Serial No. 09/626,063
Amendment Dated January 31, 2006
Reply to Office Action Mailed December 2, 2005

REMARKS

In the Office Action dated December 2, 2005, claim 49 was objected to; claim 72 was rejected under 35 U.S.C. § 112, ¶ 2; claims 49-58, 62, 64, 65, 68, and 70-82 were rejected under § 103 over U.S. Patent No. 6,504,626 (Shih) in view of U.S. Patent No. 6,642,943 (Machida); and claim 59 was rejected under § 103 over Shih and Machida in view of U.S. Patent No. 5,862,321 (Lamming).

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Appln. Serial No. 09/626,063
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OBJECTION OF CLAIM 49

Claim 49 has been amended to replace "a" with "said" at lines 6, 7, and 9 to address the objection. This claim amendment does not change the scope of the claim. Therefore, entry of this amendment for purposes of appeal is respectfully requested.

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Appln. Serial No. 09/626,063
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REJECTION UNDER 35 U.S.C. § 112, ¶ 2

Claim 72 was rejected under § 112 based on the recitation of "a scanner" at line 2. The Office Action stated that it is unclear whether "a scanner" refers to the "standalone scanner" or "another scanner." It is respectfully submitted that claim 72 is similar to dependent claim 77 in that the "standalone scanner" is further defined. In claim 77 (which was not rejected), the standalone scanner was further defined as comprising a scanner that operates independently of the computer.

Since claim 72 is a method claim, the further definition of "standalone scanner" is recited in the context of the "accessing" act specified in claim 49. Thus, in claim 72, accessing the at least one network device by *the standalone scanner* comprises accessing the at least one network device by *a scanner that operates independently of a computer*. The term "a scanner that operates independently of a computer" is provided to further define "standalone scanner" that is part of the "accessing" act of claim 72.

In view of the foregoing, it is respectfully submitted that the meaning of claim 72 is clear. Withdrawal of the § 112 rejection is respectfully requested.

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Appln. Serial No. 09/626,063
Amendment Dated January 31, 2006
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REJECTIONS UNDER 35 U.S.C. § 103

1. Claim 49

Independent claim 49 was rejected as being obvious over Shih in view of Machida. The Office Action conceded that Shih fails to disclose "displaying destination options on a user interface of the standalone scanner based on accessing the at least one network device." 12/2/2005 Office Action at 4. However, the Office Action relied upon Machida as disclosing the claim feature not disclosed by Shih. *Id.*

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 49 for at least the following reasons: (1) no motivation or suggestion existed to combine the teachings of Shih and Machida; and (2) the references when combined do not teach or suggest all elements of the claim. See M.P.E.P. § 2143 (8th ed., Rev. 3), at 2100-135.

As noted in Shih, the display 58 of the scanner 40 of Shih is able to display "key signals [of the keyboard] or the instruction messages." Shih, 3:5-7. The instruction messages can include an e-mail address that is input by the keyboard 52 (depicted in Fig. 3 of Shih). Shih, 3:36-38. As correctly noted by the Office Action, the display panel 58 of the scanner 40 of Shih does not display destination options from which selection can be made to obtain a destination as recited in claim 49.

However, contrary to the assertion in the Office Action, Machida does not provide the requisite suggestion to modify Shih to achieve the claimed invention. Machida teaches the use of a data processing apparatus (in the form of a PC shown in Fig. 2) to enable combination of functions of various devices connected to one or more networks (as depicted in Fig. 1 of Machida). As stated by Machida, the PC that provides the data processing apparatus of Fig. 2 has a CRT 16 that can show a screen containing icons (see Fig. 5 or 11 of Shih), in which a copying function can be executed by dragging the scanner icon and dropping the scanner icon on the printer icon displayed in the screen of Fig. 5. Machida, 9:39-10:51. As explained by Machida, use of the PC that makes up the data processing apparatus allows devices, such as a scanner and printer, that are disposed at physically distant locations to perform data communication for the purpose of achieving a combined function. Machida, 10:52-65. However, note that the PC (data processing apparatus), as depicted in Fig. 2 of Machida, clearly

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Appln. Serial No. 09/626,063
Amendment Dated January 31, 2006
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is not part of a *standalone scanner*. In other words, a person of ordinary skill in the art looking to the teachings of Machida would have been led away from the claimed invention. Rather than teaching a person of ordinary skill in the art that a display of destination options can be provided at the user interface of a standalone scanner, Machida would have suggested to this person of ordinary skill in the art that a central data processing apparatus (PC in Fig. 2 of Machida) be employed to allow physically distant devices to communicate with each other.

In addition, Shih does not suggest any desirability to display destination options on the display panel of the scanner in Shih. Similarly, Machida does not suggest any desirability to incorporate the screen depicted in Fig. 5 of Machida in the display of a standalone scanner. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (emphasis added).

In view of the foregoing, it is clear that no motivation or suggestion existed to combine the teachings of Shih and Machida in the manner proposed by the Office Action. A *prima facie* case of obviousness has therefore not been established with respect to claim 49 for at least this reason.

Moreover, a further defect in the obviousness rejection is that the hypothetical combination of Shih and Machida does not teach or suggest *all* elements of the claim. As conceded by the Office Action, Shih does not disclose displaying destination options on a user interface of the standalone scanner based on accessing the at least one network device. Machida also fails to disclose or suggest this element. As discussed above, Machida teaches the display of icons on a CRT of a PC, not on a user interface of a standalone scanner. Therefore, since neither Shih nor Machida teaches or suggests at least this element of the claim, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 49 for this additional reason.

2. Claim 62

Independent claim 62 was also rejected as obvious over Shih and Machida. Note that claim 62 recites a standalone scanner that comprises a browser program for accessing a network device on a network, and a display for displaying destination locations *on the network device*.

Appln. Serial No. 09/626,063
Amendment Dated January 31, 2006
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The Office Action rejected claim 62 by citing to "arguments analogous to those presented for claims 49 and 54" 12/2/2005 Office Action at 7. Note, however, that neither claim 49 nor claim 54 recites a display for displaying *destination locations on the network device* (plural destination locations on one network device). The Office Action has clearly failed to properly establish a *prima facie* case of obviousness, since the Office Action has not provided any reasoning or explanation regarding how Shih and Machida teaches or suggests a display for displaying destination locations on the network device.

It is clear that Shih does not disclose or suggest a display for displaying destination locations on a network device. Additionally, Applicant respectfully submits that Machida also fails to teach or suggest such a display for displaying destination locations on the network device. Although the screen in Fig. 5 of Machida shows various icons, it is respectfully submitted that the icons represent various PCs and peripheral devices – however, these icons do not constitute destination locations on a single network device. Therefore, for at least this reason, Shih and Machida do not teach or suggest the subject matter of claim 62.

Moreover, the obviousness rejection of claim 62 is defective for additional reasons stated above with respect to claim 49.

3. Claims 54 and 81

Independent claim 54 was also rejected as being obvious over Shih and Machida. As discussed above, it is respectfully submitted that no motivation or suggestion existed to combine the teachings of Shih and Machida. Moreover, the hypothetical combination of Shih and Machida does not disclose displaying icons representing folders in a *user interface of a standalone scanner*, as recited in claim 54.

Another defect in the rejection of claim 54 is the following further misapplication of Machida to the following element of claim 54: display icons representing the *folders* in a user interface of the standalone scanner. The Office Action cited Figs. 5 and 11 of Machida as disclosing the display of icons representing folders. Although Figs. 5 and 11 do depict icons, these icons represent PCs or peripheral devices – they do not represent folders. As understood by a person of ordinary skill in the art, a folder refers to a directory that has a collection of computer files. *See, e.g.*, FOLDOC, definition of "folder" (attached). Since neither Shih nor

Appln. Serial No. 09/626,063
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Machida discloses the display of icons that represent *folders*, this is a further basis that a *prima facie* case of obviousness has not been established with respect to claim 54.

Independent claim 81 is non-obvious over Shih and Machida for similar reasons as claim 54.

4. Conclusion


Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the defective rejection of base claim 54 over Shih and Machida, it is respectfully submitted that the rejection of claim 59 over Shih, Machida, and Lamming has been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10001122-1).

Respectfully submitted,

Date: _____

Jan 31, 2006



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